

RESPONSE UNDER 37 C.F.R. §1.116  
USSN: 08/898,853

As a preliminary matter, the Examiner has raised issues with respect to claims 13, 15, 16 and 18. However, on several previous occasions, including the Personal Interview on October 16, 2001, the Examiner confirmed that the only remaining issues is with respect to claim 13 – whether the present application provides support for claim 13 which recites a core including three layers and a cover – and that any issues concerning claims 15, 16 and 18 have been resolved. This is further shown by the Examiner’s statements on page 3 of the Office Action where only claim 13 is addressed. Accordingly, in the event the Examiner does not withdraw the rejection in its entirety, the Examiner is requested clarify the rejection as set forth in the Office Action.

Turning specifically to the issues pertaining to claim 13, Applicants submit the following remarks:

1. On page 3 of the Office Action, the Examiner’s only response is that Applicants’ position today is “at odds with that taken by the applicants in paper 6 where applicants argued that prior art showing a three piece core and a cover is ‘*completely distinguishable*’ from the ball of the applicants’ claims, (emphasis added).”

However, Applicants prior response dealt with different claims of the present application and claims of different scope than claim 13 which is now at issue. Moreover, Applicants’ prior arguments do not state that what makes the ball “completely distinguishable” was because of the naming of the inner layers as part of the core or cover. Instead, the disclosure of the prior art Higuchi patent at issue was completely distinguishable from the claims of the present application at issue.

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2. On page 3 of the Office Action, the Examiner relies on “file wrapper estoppel doctrine” and contends “applicants are estopped from now arguing that the inner cover layer may be considered an outer core layer or vice-versa.”

Applicants request that the Examiner cite authority to support the basis for reliance on file wrapper estoppel doctrine to contend that Applicants are estopped from making further arguments.

In addition, Applicants note that the prior Examiner (Marlo) of the case has taken a position that is “at odds” with the position that the current Examiner (Gordon) is taken. Applicants believe it is fundamentally unfair to the Applicants to take such different positions during the course of prosecution. Applicants believe that this further demonstrates that the Examiner should consider the merits of the argument, and not dwell on prior exchanges between the Applicants and Examiner, unless the position of the prior Examiner is considered. Here, the present Examiner is completely ignoring the positions taken by the prior Examiner.

3. The remaining issue is merely one of characterizing the inner layer (i.e., the inner cover layer 15 in the present application) as being part of the cover or core.

Applicants rely upon and incorporate by reference herein the remarks, arguments and evidence in the Response Under 37 C.F.R. §1.111 filed on December 21, 2001.

In addition, Applicants submit herewith a chart, listing various U.S. Patents which were filed close to the filing date of the present application and which pertain to four-piece golf balls. The listed patents demonstrate that the names of the second layer and third layer from innermost layer of the golf ball are not determined by any specific rule of the golf ball manufacturers, or the industry in general. Instead, the layers are named by the inventors and his own personal views.

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The listed patents show that the names of the second layer and the third layer are used loosely and are characterized in no special way. As the attached chart shows, the second and the third layer are named core or cover or intermediate layer. That is, the second and the third layer are called as a part of a core, a part of a cover or an intermediate layer. Also, the types of materials used, including rubbers and resins based materials, in the second and the third layer do not enable a division between what is a cover or a core.

In sum, though the innermost can be called “core” and the outermost layer can be called “cover,” the sandwiched layers, or layers between the two, cannot be defined as a core or a cover uniformly. Simply put, there is no rule on the naming convention used.

Applicants respectfully submit that the focus is not the name of the second layer and the third layer but the technical features such as the use materials used and the hardness of the second layer and the third layers. The Examiner should not be caught up by the names of these layers, but should instead consider the present invention in view of the technical elements or characteristics (e.g., composition and hardness) of the various layers and their relative positions in the construction of the ball. Accordingly, Applicants submit that if one layer of a four-piece golf ball is formed with the same material and located at the same position as that of another layer of another four-piece golf ball, then practically speaking that one layer is substantially identical to other layer.

For all of the foregoing reasons, Applicants respectfully request that the present rejection of claims 13-19 be withdrawn and be allowed. Applicants respectfully request an interview to review the patents listed in the attached chart should the Examiner not withdraw the rejection.

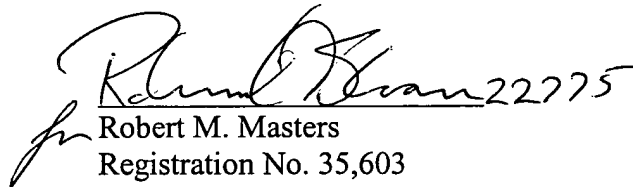
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In view of the above, reconsideration and allowance of this application are now believed in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

  
Robert M. Masters  
Registration No. 35,603

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\*Layer 3 is the third innermost layer of 4P ball

USP No.	Assignee	Name of second innermost layer (layer 2)	material for layer 2	Name of second outermost layer (layer 3)	material for layer 3	Remarks
5,702,311	BSP	inner intermediate layer	rubbers, resins, thermoplastic resins, rubbers	outer intermediate layer	rubbers, resins, preferably thermoplastic resins	Both inner and outer intermediate layers are regarded as parts of core, see ll. 11 to 20 of col. 4
5,688,595	BSP	surrounding layer	rubbers, resins	inner cover layer	ditto	Layer 2 is a part of core; please see last line of col. 2 to first line of col. 3. Layer 3 is a part of cover; please see ll. Layer 2 is a part of core; please see second last paragraph of col. 2. Layer 3 is a part of cover. Please see the second last paragraph of col. 2.
5,725,442	BSP	surrounding layer	rubbers, resins	inner cover layer	ditto	This invention shows at least three-layered cover.
5,733,205	BSP	surrounding layer	ditto	inner cover layer	ditto	
5,818,937	BSP	innermost layer of cover	resins	intermediate layer of cover	resins	
5,273,286	D.J.C. Sun	intermediate core	carbonaceous materials	outer core	elastomer	three-piece core and cover
5,749,816	Kasco	intermediate layer of core	rubbers, resins	outer layer of core	rubbers, resins	three-layered core
5,830,086	BSP	surrounding layer	rubbers, resins	inner cover layer	preferably thermoplastic resins	two-layered core and two-layered cover
5,772,531	Kasco	intermediate layer of core	rubbers, resins	outer layer of core	rubbers, resins	three-layered core
5,783,284	Acushnet	inner layer of cover	polymers (rubber resins), ionomer resin	intermediate layer of cover	polymers (rubber resins), ionomer resin	three-layered cover
5,980,356	Surintomo	inner layer of intermediate layer	resins, rubbers	outer layer of intermediate layer	resins, rubbers	intermediate layer has a two parts.